

### **DETAILED ACTION**

1. Applicant's amendments and remarks, filed January 22<sup>nd</sup>, 2010, have been fully considered by the Examiner. During the interview held on March 9<sup>th</sup>, 2010, Applicant waived the First Action Interview Office Action and requested that the proposed amendment of January 22<sup>nd</sup>, 2010 be entered. Currently, claims 19-21 and 23-38 are pending with claims 1-18 and 22 cancelled claims 19-21 amended and claims 33-38 withdrawn. It is noted that the claim listing for claims 1-18 is currently missing. During the March 9<sup>th</sup>, 2010 interview, Applicant was made aware of the omission and indicated that claims 1-18 are to remain cancelled as indicated in the July 13<sup>th</sup>, 2007 claim listing. Applicant's amendment to claims 20 and 21 has obviated the previously filed rejection of each claim under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. The following is a complete response to the January 22<sup>nd</sup>, 2010 s communication.

#### ***Claim Objections***

2. Claims 20-21 and 23-31 are objected to because of the following informalities:
3. Regarding each of claims 20-21 and 23-31, each of the claims incorrectly lists dependency on cancelled claim 1. During the March 9<sup>th</sup>, 2010 interview, Applicant indicated that dependency for each of the claims was to be from pending claim 19. As such, the claims will be interpreted as dependent from claim 19. It is suggested that Applicant amend each claim to indicate such dependency. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

4. Claims 19-21, 23-29 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pennybacker et al (US Pat. No. 5,637,110) in view of Levin (US Pat. No. 5,827,281).

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Regarding claim 19, Pennybacker discloses a fluid-assisted electrosurgical (see col. 6; 50-64) device to treat tissue comprising (see figures 1 and 26) an end effector comprising a first member and a second member (jaw unit **12** with jaws **170**), the first member and the second member pivotally connected (connected via pivot pin **192**), at least one of the first member and the second member electrically coupled (see col. 6; 50-64) to an electrical connector (terminal pin **94**) connectable to a radio frequency power source (current source **95**), a fluid passage (passage formed by flat **146** on rod **50** and tube **51**) in fluid communication with at least one fluid outlet (fluid exit at the end of flat **146**) positioned to expel a fluid to the end effector and obstructed from contact with tissue by at least one of the members. While Pennybacker shows in the embodiments of figures 1 and 26 that the end effector with the first and second member is an electrosurgical grasper having conventional jaws, Pennybacker further discloses that the convention jaws can be replaced with scissor jaws capable of scissor-like cutting (see col. 9; 48-54). Pennybacker fails to show the structure or shape of these scissor jaws. Levin discloses a similar electrosurgical device as that of Pennybacker including an end effector having a first and second blade member (jaws **22A**, **22B**) pivotally connected and arranged to cut tissue (see col. 2; 53-56). Levin further discloses (see figure 3) for each blade member to have a bulbous portion protruding from the blade member (tips **30A**, **30B**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the electrosurgical scissor arrangement as shown by Levin as the electrosurgical scissors of Pennybacker to provide for a combined device which can both sever and coagulate tissue at a target tissue site. The combined functionality eliminates the need for two separate tools to be used during treatment

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thereby reducing treatment time and the chance of complications arising due to multiple insertions of different devices.

Regarding claim 20, Pennybacker discloses that the end effector is supplied with monopolar electrosurgical energy thereby making the combined electrosurgical scissors as in above claim 19 monopolar (see col. 6; 50-64).

Regarding claim 21, Pennybacker discloses that the device functions electrosurgically and in a laparoscopic manner (see abstract, figure 1 and col. 6; 50-64).

Regarding claim 23, Pennybacker fails to disclose any specifics of the blade structure. Levin discloses (see figure 3) that the first blade member comprises a first blade member exterior surface, the second blade member comprises a second blade member exterior surface and at least one of the first blade member exterior surface and the second blade member exterior surface at least partially comprises an electrically insulative material (insulative layer **27**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the end effector/blade arrangement of Levin as the scissor arrangement of Pennybacker to provide for a combined electrosurgical device which only supplies electrosurgical energy to a targeted portion of tissue. By supplying an insulative layer as in Levin, non-target tissue is shielded from the effects of the applied electrosurgical energy thereby preventing unwanted collateral damage.

Regarding claim 24, Pennybacker fails to disclose any specifics of the blade structure. Levine discloses (see figure 3) that the first blade member comprises a first blade member shearing surface (interior surface of **22A**), the second blade member comprises a second blade member shearing surface (interior surface of **22B**) and the first blade member shearing surface

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and the second blade member shearing surface face one another when the first blade member and the second blade member are in a closed position (see position in figure 3). Therefore, it would have been obvious to one of ordinary skill in the art that in utilizing the structure of Levin as the scissors of Pennybacker as in claim 19 above, that the end effector would contain such a structural arrangement.

Regarding claim 25, Pennybacker discloses (see figure 8 and col. 9; 5-18) an elongated shaft, a lumen located within the shaft; and the lumen providing a portion of the fluid passage (extension of tube **51** with space therein and the distal opening at the end of the tube **51**).

Regarding claim 26, Pennybacker discloses an elongated shaft and the at least one fluid outlet is located within the shaft (extension of tube **51** with space therein and the distal opening at the end of the tube **51**).

Regarding claim 27, Pennybacker discloses a push rod, a lumen located within the push rod and the lumen providing a portion of the fluid passage (extension of tube **51** with space therein and the distal opening at the end of the tube **51**).

Regarding claim 28, Pennybacker discloses that the fluid passage passes through a connector member that couples the blade members to a push rod (see figures 13 and 20 with arm **163** providing such a coupling).

Regarding claim 29, Pennybacker discloses that the at least one fluid outlet is provided by a connector member which couples the blade members and a push rod (see figures 13 and 20, the relation of **51**, **50**, and **63** and in view of col. 9; 5-18).

Regarding claims 31 and 32, Pennybacker fails to disclose any specifics of the blade structure. Levine discloses (see figure 3) that the first blade member comprises a first blade

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member exterior surface (exterior surface of **22A**), the second blade member comprises a second blade member exterior surface (exterior surface of **22B**) wherein at least one of the exterior surfaces is configured to slide along tissue while the exterior surface is coupled adjacent the tissue with a fluid expelled from the fluid outlet and radio frequency power is provided to the tissue from the scissors and wherein at least one of the exterior surfaces is further configured such that the fluid expelled from the fluid outlet forms a localized fluid coupling between a surface of the tissue and the exterior surface when the exterior surface is located adjacent the surface of the tissue. Therefore, it would have been obvious to one of ordinary skill in the art that in utilizing the structure of Levin as the scissors of Pennybacker as in claim 19 above, that the end effector would contain such a structural arrangement. It is noted that the "configured to" language in the claim is being interpreted as a recitation of intended use and/or functional language and as such, it is the Examiner's position that the combined device of Pennybacker and Levin is capable of performing such a function. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pennybacker et al (US Pat. No. 5,637,110) in view of Levin (US Pat. No. 5,827,281) as applied to claim 19 above and further in view of Rydell (US Pat. No. 5,352,222).

Regarding claim 30, Both Pennybacker and Levin fail to disclose that at least one of the blade members is curved. Rydell discloses a similar electrosurgical device as that of Pennybacker and Levin having an end effector with a first and second blade member (see figure

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2). Rydell further discloses that the first and second blade member is curved (see shape in figure 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the curved shaped of the blade members of Rydell to the blade members of the combined device of Pennybacker and Levin. Rydell discloses the interchangeability between the two variations, straight and curved, in col. 4; 35-45 and one of ordinary skill would readily recognize that such a change is an obvious design choice given the prior art and the desire to access different target areas within a patient's body.

### ***Response to Arguments***

6. Applicant's arguments, see pages 7-9 of the Remarks, filed January 22nd, 2010, with respect to the rejection(s) of claim(s) 19-22, 24-29 and 31-32 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Pennybacker et al (US 5,637,110) in view of Levin (US 5,827,281).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RONALD HUPCZEY, JR whose telephone number is (571)270-5534. The examiner can normally be reached on Monday - Friday, 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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